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10/677,716	10/02/2003	Amr Salahieh	1001.1633101	9204

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EXAMINER	
TYSON, MELANIE RUANO	

ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	**Application No.** 10/677,716	**Applicant(s)** SALAHIEH ET AL.	
	Examiner Melanie Tyson	**Art Unit** 3773	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2009*.
2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2,4-12,14-16,18-26,28 and 29* is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1,2,4-12,14-16,18-26,28 and 29* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a)☐ All b)☐ Some * c)☐ None of:
1.☐ Certified copies of the priority documents have been received.
2.☐ Certified copies of the priority documents have been received in Application No. _____.
3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

This action is in response to the applicant's amendment received on 10 February 2009.

Claims 3, 13, 17, and 27 remain cancelled.

Response to Arguments

Applicant's arguments filed 10 February 2009, with respect to the 35 USC § 112 and 35 USC § 102 rejections have been fully considered and are persuasive. Therefore, the rejections have been withdrawn and a new rejection is set forth below.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 2, 8-12, 14-16, 19, 23-26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Boyle et al. (U.S. Patent No. 2003/0004537 A1)** and **Carlson et al. (U.S. Patent No. 5,814,058)**.

Boyle discloses a medical device for retrieving an intravascular device from a body lumen (see entire document) comprising an elongated shaft (112; for example, see Figure 12) having a proximal section (not shown in Figure 12; refer to Figure 1 for illustration of entire device in which portion 22 may be considered the proximal end) and a flared distal section (118), wherein the medical device is capable of retrieving an embolic protection device as claimed. Boyle further discloses a member (116) that is encased in an elastic jacket (114) and is coupled to the distal section by using adhesives, or other bonding or molding techniques, and extends distally of the distal section, wherein the member defines a radially expandable inner lumen. Boyle fails to disclose the expandable member is a braided member.

Carlson discloses a sheath for introducing surgical instruments into a body (see entire document). Carlson teaches the sheath comprises a braided member (14) including a plurality of filaments (for example, see column 8, lines 34-35) that are capable of radially expanding if axially compressed (for example, see column 8, lines 37-38). Carlson further teaches the filaments may comprise a polymeric material, a metal, and/or an elastomeric jacket including silicone (for example, see column 8, lines 27-37). Expandable lumens comprising a ring-like structure encased in an elastic jacket were known in the art, as evidenced by Boyle, while expandable lumens comprising a braided structure encased in an elastomeric jacket were known in the art as evidenced by Carlson. One of ordinary skill in the art could have substituted Boyle’s ring-like structure encased in an elastic jacket with a braided structure encased in an elastomeric jacket by known methods. For example, Carlson discloses coupling the expandable member with adhesive, and the results would have been a predictable use of expandable members. Thus, it would have been obvious to one of ordinary skill in the art to replace the ring-like structure encased in an elastic jacket with a braided structure encased in an elastomeric jacket.

With further respect to claims 2 and 16, Boyle discloses the elongated shaft (112) includes any suitable elastic material. Boyle further discloses an alternate embodiment in which the elongated shaft member includes an elastic material such as polyether block amide. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the elongated shaft of Figure 12 from polyether block amide, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

With further respect to claims 12 and 26, Carlson discloses an elastomeric jacket. It would have been obvious to one having ordinary skill in the art at the time the invention was made to form the elastomeric jacket from urethane, a well known elastomeric material in the art, as opposed to the examples listed by Carlson, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of design choice.

With further respect to claims 14 and 28, Boyle and Carlson fail to disclose the elastomeric jacket includes a radiopaque material. However, it is well known in the art to coat medical devices with radiopaque material in order to be able to view the devices under fluoroscopy during a medical procedure. Therefore, to include radiopaque material in the elastomeric jacket of Boyle in view of Carlson would have been obvious to one of ordinary skill in the art at the time the invention was made in order to be able to view the path and/or placement of the device during the procedure.

Claims 4-7, 18, 20-22, and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Boyle et al.** and **Carlson et al.** as applied to claims 1 and 15 above, and further in view of **Dubrul et al. (U.S. Patent No. 6,221,006 B1)**.

Boyle and Carlson disclose the claimed invention (regarding claim 29, see above for the description of similar limitations recited in claims 1 and 15) except for a plurality of filaments arranged in two sets of parallel helices wound in opposite directions about a common longitudinal axis, wherein the plurality of filaments comprise multi-filar threads and/or a composite radiopaque material. Dubrul discloses a medical device comprising a radially expandable braided member (see entire document). Dubrul teaches the braided member is similar in configuration to the embolic protection filter (or TRAP, another braided member disclosed by Dubrul et al.), in which the plurality of filaments are multi-filar threads (a mesh of individual filaments called yarns; for example, see column 14, lines 44-45) that may be formed of composite material (interweaving elastic and inelastic filaments; for example, see column 14, lines 44-47), including platinum (a radiopaque material), and the plurality of filaments are arranged in two sets of parallel helices wound in opposite directions about a common longitudinal axis (a tubular braid that is formed by moving one system of yarn helically clockwise with respect to the axis and another helically counterclockwise; for example, see column 15, lines 9-11). Dubrul teaches this configuration enables the braided member to be easily placed in an expanded state when subjected to a compressive force and in a relaxed state when subjected to a tensile force (for example, see column 15, lines 34-40). It is well within the general knowledge of one having ordinary skill in the art to apply a known technique to a known device ready for improvement to yield predictable results. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to arrange the braid of Boyle in view of Carlson as claimed. Doing so would facilitate expansion and relaxation of the distal section of the expandable member.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melanie Tyson whose telephone number is (571)272-9062. The examiner can normally be reached on Monday through Friday 7-7 (max flex).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Melanie Tyson /M. T./
Examiner, Art Unit 3773
February 28, 2009

/(Jackie) Tan-Uyen T. Ho/
Supervisory Patent Examiner, Art Unit 3773